

Amendments to the Drawings

The attached drawing sheet includes changes to Fig. 32. In the replacement sheet, various elements, such as element 92, have been given labels.

Attachment: Replacement Sheet

Remarks/Arguments

New Claims

New Claim 71 is fully supported by the specification, for example, page 18, line 13 to page 19, line 12. Therefore, no new matter has been added.

The Rejection of Claims 14, 22, 52, 57, 60, 61, 66 and 69 Under 35 U.S.C. §102(a)

The Examiner rejected Claims 14, 22, 52, 57, 60, 61, 66 and 69 under 35 U.S.C. §102(a) as being anticipated by PCT Publication WO 00/75851 (Goffman et al).

Anticipation requires that all of the elements of the claim be taught within the four corners of a single reference.

Claim 14

Goffman does not consider linguistic components

To remove any possible ambiguity between “linguistic components” and “textual components,” the later element has been removed from Claim 14 so that amended Claim 14 recites: “analyzing said set of patents by consideration of a number of linguistic components in at least one independent claim in said each patent,”

“This means that the words of the claim must be given their plain meaning unless **>the plain meaning is inconsistent with< the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say..)” MPEP 2111.01(I).

"[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, *>415 F.3d 1303, 1313<, 75 USPQ2d 1321>, 1326< (Fed. Cir. 2005) (*en banc*). *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v.*

Intuitive Surgical, Inc., 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."). **It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims.** *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003) (emphasis added).

"The ordinary and customary meaning of a term may be evidenced by a variety of sources, >including "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art."< *Phillips v. AWH Corp.*, *>415 F.3d at 1314<, 75 USPQ2d **>at 1327.<

"[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning."). Compare *MSM Investments Co. v. Carolwood Corp.*, 259 F.3d 1335, 1339-40, 59 USPQ2d 1856, 1859-60 (Fed. Cir. 2001)

The ordinary meaning in the usage of the field of the subject invention for the word "linguistic" can be found at the following website: www.asis.org/Bulletin/Apr-98/liddy.html, which provides the following information and definitions:

"The levels of linguistic analysis are:

1. **Phonological:** interpretation of speech sounds within and across words
2. **Morphological:** componential analysis of words, including prefixes, suffixes and roots
3. **Lexical:** word level analysis including lexical meaning and part of speech analysis
4. **Syntactic:** analysis of words in a sentence in order to uncover the grammatical structure of the sentence
5. **Semantic:** determining the possible meanings of a sentence, including disambiguation of words in context
6. **Discourse:** interpreting structure and meaning conveyed by texts larger than a sentence

7. **Pragmatic:** understanding the purposeful use of language in situations, particularly those aspects of language which require world knowledge”

Paragraph [0059] of the subject application states: “Another metric relates to a weighted count of *linguistic* or textual *components* found in the claim(s) under study or of correlations among such components. *These components may be determined via analysis at various linguistic levels, including phonological, morphological, lexical, syntactic, semantic, discourse structure, or pragmatic levels.*” (emphasis added). Thus, the specification confirms that the meaning of linguistic is in line with the ordinary and customary usage of the word for those skilled in the art.

Further, “An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Applicants have done nothing to set forth a definition of “linguistic” that is different than the ordinary and customary meaning of the word.

The Examiner cited page 19, lines 1-18 and page 20, lines 20-24 of Goffman as teaching the above claim limitation. However, Goffman has no teaching regarding linguistic components. For example, Goffman has no teachings regarding phonological, morphological, lexical, syntactic, semantic, discourse structure, or pragmatic aspects of the claims being considered. Instead, on page 19, Goffman teaches rote mechanical processes such as measuring the lengths of data fields, counting entries in data fields, counting claims, claim clauses, citations, examples, numbers of figures, and priority claims.

Regarding claim length, Goffman teaches counting the number of characters, words, paragraphs, columns of text, pages of text, number of graphics, or area of text or graphics. On page 20, Goffman teaches apprising claim length (number of words) and the number of number of independent claims. None of these processes or methods is related to linguistic analysis. Therefore, Goffman does not teach the above limitation of Claim 14.

Response to Arguments section of the Office Action

In the Response to Arguments section of the Office Action, the Examiner stated: “Regarding the Applicants' argument that the prior art of record, including both the Applicants' Admitted Prior Art and also the Goffman et al. reference, fails to disclose the claimed number of elements in an independent claim or a number of linguistic or textual components in at least one independent claim, the examiner respectfully disagrees. The claim recites the counting of either the number of elements in a claim, or the number of linguistic or textual components in a claim. Clearly, giving the claim terms their broadest reasonable interpretation, *counting the number of words in a claim would anticipate the claimed counting the number of linguistic or textual components. Words would certainly qualify as textual components.* As such, the counting of the number of words in a claim anticipates the claimed counting of linguistic or textual components.” (emphasis added).

Amended Claim 14 only recites linguistic components. Assuming *arguendo* that the Examiner's argument is applied to the linguistic components recited in Claim 14, Applicants note that words in and of themselves do not qualify as linguistic components. Linguistic components may, in general, be derived from words, but a word count is not a linguistic component. For example, Applicants have reprinted the linguistic categories noted above and has attempted to correlate a word count with each category as follows:

Phonological: interpretation of speech sounds within and across words. A word count has no bearing on speech sounds.

Morphological: componential analysis of words, including prefixes, suffixes and roots. A word count sheds no light on components of the word.

Lexical: word level analysis including lexical meaning and part of speech analysis. A word count is irrelevant to lexical meaning and part of speech.

Syntactic: analysis of words in a sentence in order to uncover the grammatical structure of the sentence. A word count is inapplicable to structure.

Semantic: determining the possible meanings of a sentence, including disambiguation of words in context. A word count is useless for determining meanings.

Discourse: interpreting structure and meaning conveyed by texts larger than a sentence. Clearly a word count does not lend any information regarding a sentence, much less larger texts.

Pragmatic: understanding the purposeful use of language in situations, particularly those aspects of language which require world knowledge. A word count is again of no relevance.

Therefore, Applicants respectfully request that the Examiner explain under which specific linguistic component, i.e., phonological, morphological, lexical, syntactic, semantic, discourse structure, or pragmatic, a word count falls.

“Counting the number of words” is not analogous to counting the number of linguistic components.

Further, amended Claim 14 does not recite counting the number of words. Therefore, assuming *arguendo* that the above argument by the Examiner is valid, which it is not, the arguments are inapplicable to the claim.

Goffman does not assign a strength rating based on the analysis recited in Claim 14

Claim 14 recites: “assigning a strength ranking to said each patent responsive to said analysis” The Examiner has cited page 19, lines 1-18 and page 20, lines 20-24 of Goffman as teaching the above claim limitation. Applicants have shown that Goffman does not teach the analysis recited in Claim 14. Therefore, Goffman does not teach assigning a strength ranking based on the analysis and does not anticipate the above limitation of Claim 14.

For all the reasons noted above, Goffman does not teach all the elements of Claim 14 and Claim 14 is novel with respect to Goffman. Claims 52, 57 and 60, dependent from Claim 14, enjoy the same distinction with respect to Goffman.

Claim 22

Amended Claim 22 is an apparatus claim paralleling method Claim 14. Therefore, the arguments regarding Claim 14 are applicable to Claim 22 and Claim 22 is novel with respect to Goffman. Claims 61, 66, and 69, dependent from Claim 22, enjoy the same distinction with respect to Goffman.

New Claim 70

New Claim 70 recites: “analyzing said set of patents by consideration of a number of elements in an independent claim of said each patent;”

The Examiner has cited page 19, lines 1-18 from Goffman as teaching the above limitation. However, Goffman has no teaching regarding the number of elements in an independent claim. For example, Goffman teaches measuring lengths of data fields, the number of independent claims of each class, total number of claims, number of independent claims, total number of claims, number of classes of independent claims.

Claim 70 recites: “assigning a strength ranking to said each patent responsive to said analysis” Applicants have shown that Goffman does not teach the analysis recited in Claim 70. Therefore, Goffman does not teach assigning a strength ranking based on the analysis and does not anticipate the above limitation of Claim 70.

For all the reasons noted above, Goffman does not teach all the elements of Claim 70 and Claim 70 is novel with respect to Goffman.

New Claim 71

New Claim 71 recites: “determining a respective number of elements in said each independent claim;” The arguments for Claim 70 are applicable to this element of Claim 71.

New Claim 71 recites: “for said each patent, identifying a respective first independent claim from among said each independent claim, where said respective first independent claim has a smallest said respective number of elements;” Goffman does not teach identifying the number of elements of an independent claim and therefore cannot teach the above element. Assuming *arguendo* that Goffman does teach counting elements in an independent claim, which is not the case, Goffman has no teachings regarding the identification of an independent claim having a smallest number of elements.

Claim 71 recites: “for said each patent, assigning a respective weighted strength ranking, said respective weighted strength ranking being proportional to a respective predetermined coefficient;” Assuming *arguendo* that Goffman teaches counting elements in an independent

claim and identifying a first claim, which is not the case, Goffman has no teachings regarding a weighted strength ranking and predetermined coefficient.

For all the reasons noted above, Goffman does not teach all the elements of Claim 71 and Claim 71 is novel with respect to Goffman.

New Claim 72

New Claim 72 is an apparatus claim paralleling new Claim 70. Therefore, the arguments regarding Claim 70 are applicable to Claim 72 and Claim 72 is novel with respect to Goffman.

Applicants courteously request that the rejection be removed.

The Rejection of Claim 22 Under 35 U.S.C. §102(a)

The Examiner rejected Claim 22 under 35 USC 102(a) as being anticipated by Applicants' admitted prior art.

Anticipation requires that all of the elements of the claim be taught within the four corners of a single reference.

Claim 22

Prior Art does not teach consideration of a number of linguistic components in a claim

Claim 22 recites: "means for analyzing said set of patents by consideration of a number of *linguistic components* in at least one claim in said each patent;" (emphasis added).

The Examiner stated: "Regarding claim 22, **Admitted Prior Art** teaches a method for ranking a set of patents according to strength, comprising: a) analyzing said set of patents by consideration of at least one objective parameter of each patent in said group, said at least one objective parameter selected from the group consisting of number of elements in an independent claim of said each patent, and number of linguistic or textual components in at least one independent claim in each patent (see disclosure that in general, the fewer claim elements or words in a claim, the broader its scope, paragraph [0012]);"

The above excerpt contains no teaching regarding linguistic components. The number of elements in a claim is not a linguistic component. As has been shown *supra*, linguistic analysis and linguistic components are with respect to components such as phonological, morphological,

lexical, syntactic, semantic, discourse structure, or pragmatic. Thus, assuming *arguendo* that the above excerpt had any bearing under 35 USC 102(a), which is not the case, the excerpt contains no teachings regarding linguistic components.

Further, Claim 22 does not recite a conclusion, or relationship, regarding a number of claim elements and the breadth of a claim. The above excerpt expresses an abstract idea and does not teach a concrete function or structure. The above excerpt does not teach any means for any purpose what so ever. Specifically, the above excerpt does not teach a means for analysis. Even more specifically, the above excerpt does not teach a means for analyzing linguistic components.

Prior Art does not teach strength ranking as recited in Claim 22

The Examiner also stated: “(b) means for assigning a strength ranking to said each patent responsive to said analysis (see disclosure that the claim structure and scope are two of the criteria that determine the "strength" of a patent, paragraph [0014]).”

Claim 22 recites: “means for assigning a strength ranking to said each patent responsive to said analysis,” The Examiner has cited paragraph [0014] of the instant application as teaching the preceding limitation. Applicants have shown that the prior art does not teach the analysis recited in Claim 22. Therefore, the prior art cannot teach assigning a strength ranking based on the analysis and does not teach the above limitation of Claim 22.

For all the reasons noted above, the prior art does not teach all the elements of Claim 22 and therefore, Claim 22 is novel with respect to the prior art.

New Claim 70

The above rejection was specifically applied to an apparatus claim. New Claim 70 is a method claims, therefore, the rejection is moot with respect to Claim 70.

New Claim 71

New Claim 71 recites: “determining a respective number of elements in said each independent claim;” The arguments for Claim 70 are applicable to this element of Claim 71.

New Claim 71 recites: “for said each patent, identifying a respective first independent claim from among said each independent claim, where said respective first independent claim

has a smallest said respective number of elements;" The excerpts noted above contain no information or concepts regarding a first independent claim having a smallest number of elements.

Claim 71 recites: "for said each patent, assigning a respective weighted strength ranking, said respective weighted strength ranking being proportional to a respective predetermined coefficient;" The excerpts noted above contain no information or concepts regarding a weighted strength ranking and predetermined coefficient.

For all the reasons noted above, the prior art does not teach all the elements of Claim 71 and Claim 71 is novel with respect to the prior art.

New Claim 72

New Claim 72 recites: "means for analyzing said set of patents by consideration of a number of elements in an independent claim of said each patent;" Claim 72 does not recite a conclusion, or relationship, regarding a number of claim elements and the breadth of a claim. The above excerpt expresses an abstract idea and does not teach a concrete function or structure. The above excerpt does not teach any means for any purpose what so ever. Specifically, the above excerpt does not teach a means for analysis. Even more specifically, the above excerpt does not teach a means for analyzing a number of elements in an independent claim.

New Claim 72 recites: "means for assigning a strength ranking to said each patent responsive to said analysis" The Examiner has cited paragraph [0014] of the instant application as teaching the preceding limitation. Applicants have shown that the prior art does not teach the analysis recited in Claim 72. Therefore, the prior art cannot teach assigning a strength ranking based on the analysis and does not teach the above limitation of Claim 72.

Applicants courteously request that the rejection be removed.

Rejection of Claims 53, 54, 58, 59, 62, 63, 67 and 68 under 35 U.S.C. §103(a)

The Examiner rejected Claims 53, 54, 58, 59, 62, 63, 67 and 68 under 35 USC 103(a) as being unpatentable over PCT Publication WO 00/75851 (Goffman et al) as applied to Claims 14, 22, 52, 57, 60, 61, 66, and 69.

Claim 14

Applicants have shown that Goffman does not teach all the elements of Claim 14, nor does Goffman suggest or motivate the elements of Claim 14. Therefore, Claim 14 is patentable over Goffman. Claims 53, 54, 58 and 59, dependent from Claim 14, enjoy the same distinction with respect to Goffman.

Claim 22

Applicants have shown that Goffman does not teach all the elements of Claim 22, nor does Goffman suggest or motivate the elements of Claim 22. Therefore, Claim 22 is patentable over Goffman. Claims 62, 63, 67 and 68, dependent from Claim 22, enjoy the same distinction with respect to Goffman.

Applicants courteously request that the rejection be removed.

Rejection of Claims 55, 56, 64 and 65 under 35 U.S.C. §103(a)

The Examiner rejected Claims 55, 56, 64 and 65 under 35 USC 103(a) as being unpatentable over PCT Publication WO 00/75851 (Goffman et al) as applied to Claims 14, 22, 52, 57, 60, 61, 66, and 69 and further in view of U.S. Patent No. 5,774,833 (Newman).

Claim 14

Applicants have shown that Goffman does not teach, suggest, or motivate the elements of Claim 14. Newman teaches identifying semicolons in an independent claim and using the semicolons to count the number of claim elements. Newman does not teach, suggest, or motivate the linguistic analysis recited in Claim 14. Therefore, Newman does not cure the defects of Goffman with respect to Claim 14 and Claim 14 is patentable over Goffman and Newman. Claims 55 and 56, dependent from Claim 14, enjoy the same distinction with respect to Goffman and Newman.

Claim 22

Claim 22 is an apparatus claim paralleling method Claim 14. Therefore, the arguments regarding Claim 14 are applicable to Claim 22 and Claim 22 is patentable over Goffman and

Newman. Claims 64 and 65, dependent from Claim 22, enjoy the same distinction with respect to Goffman and Newman.

Applicants courteously request that the rejection be removed.

Rejection of Claims 14, 52-54, 57-63 and 66-69 under 35 U.S.C. §103(a)

The Examiner rejected Claims 14, 52-54, 57-63 and 66-69 under 35 USC 103(a) as being unpatentable over Applicants' admitted prior art.

Claim 14

Amended Claim 14 recites: "analyzing said set of patents by consideration of a number of linguistic components in at least one independent claim in said each patent," Applicants have shown *supra* that the prior art does not teach a linguistic component or analyzing a linguistic component in a claim. Nor does the prior art suggest or motivate a linguistic component or analyzing a linguistic component in a claim. Therefore, Claim 14 is patentable over the prior art. Claims 52-54 and 57-60, dependent from Claim 14, enjoy the same distinction with respect to the admitted prior art.

Claim 22

Applicants have shown that the prior art does not teach all the elements of Claim 22. Nor does the prior art suggest or motivate the prior art. Therefore, Claim 22 is patentable over the prior art. Claims 61-63 and 66-69, dependent from Claim 22, enjoy the same distinction with respect to the prior art.

Applicants courteously request that the rejection be removed.

Rejection of Claims 55, 56, 64 and 65 under 35 U.S.C. §103(a)

The Examiner rejected Claims 55, 56, 64 and 65 under 35 USC 103(a) as being unpatentable over Applicants' admitted prior art as applied to Claims 52-54, 57-63 and 66-69 and further in view of U.S. Patent No. 5,774,833 (Newman).

Claim 14

Applicants have shown that Claim 14 is both novel with respect to and patentable over the prior art. Newman teaches identifying semicolons in an independent claim and using the semicolons to count the number of claim elements. Newman does not teach, suggest, or motivate the linguistic analysis recited in Claim 14. Therefore, Newman does not cure the defects of the prior art with respect to Claim 14 and Claim 14 is patentable over the prior art and Newman. Claims 55 and 56, dependent from Claim 14, enjoy the same distinction with respect to the prior art and Newman.

Claim 22

Claim 22 is a system claim paralleling method Claim 14. Therefore, the arguments regarding Claim 14 are applicable to Claim 22 and Claim 22 is patentable over the prior art and Newman. Claims 64 and 65, dependent from Claim 22, enjoy the same distinction with respect to the prior art and Newman.

Applicants courteously request that the rejection be removed.

Conclusion

Applicants respectfully submit that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

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Appendix